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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,500

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Ross C. Terrell

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HODGSON RUSS LLP
INTELLECTUAL PROPERTY LAW GROUP
ONE M & T PLAZA
SUITE 2000
BUFFALO, NY 14203-2391

EXAMINER

DAVIS, BRIAN J

ART UNIT

PAPER NUMBER

1621

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/644,500
Filing Date: August 20, 2003
Appellant(s): TERRELL, ROSS C.

Martin Linihan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 30, 2004 appealing from the
Office action mailed January 27, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will direct affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-13 and 18-24.

Claims 14-17 and 25-42 have been canceled.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

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The brief is deficient because appellants make reference to a variety of features not required by the claims. Claim 4 is representative of the claimed invention. Claim 4 merely provides:

A method for the preparation of sevoflurane which comprises:

- (a) providing a liquid mixture of $(\text{CF}_3)_2\text{CHOCH}_2\text{Cl}$, hydrogen fluoride, and an amine and
- (b) reacting the mixture to form $(\text{CF}_3)_2\text{CHOCH}_2\text{F}$.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct.

(7) Grouping of Claims

The rejection of claims 1-13 and 18-24 under 35 USC 103(a) as being unpatentable over Muffler (DE 2,823,969) in view of Regan (US 3,683,092) stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the appendix to the brief is correct.

(9) Prior Art of Record

US 3,683,092	REGAN	8-1972
US 5,969,193	TERRELL	10-1999
DE 2,823,969	MUFFLER	12-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC 103(a)

Claims 1-13 and 18-24 stand rejected under 35 USC 103(a) as being unpatentable over Muffler (DE 2,823,969) in view of Regan (US 3,683,092). Muffler teaches the instant process except for the specific reactants claimed. It is noted that Muffler makes reference to hydrofluorides of nitrogen bases, which differs from the claims reciting a mixture containing hydrogen fluoride and an amine. However, the reference indicates that the hydrofluorides can be generated *in situ* from the hydrogen fluoride and the amine, note the top of page 9 of the translation provided by applicants in the parent application. Muffler does not teach some of the instant starting materials (and the corresponding final products). Such reactants differ only as to substituents that are removed from the reaction site and do not enter into the reaction. One would not expect the different substituents to affect the outcome of the reaction. One would be motivated to use the instant reactants in the prior art process since one would readily recognize the reactants necessary to afford the final products having the desired structure. Nothing patentable is seen in the use of a new starting material in an otherwise old process. Moreover, Regan clearly teaches that the instant reactants are known to react with fluorination agents to afford the same products. It would be readily apparent to one that the instant starting material could be used in the Muffler process to afford the instant products. Moreover, it is considered that the prior art provides further

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motivation to modify the prior art. Particularly note pages 4 and 5 of the translation provide in the parent application, where the advantages over other processes are pointed out. One would be motivated to use the Muffler process in order to realize the advantages suggested in the reference.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is noted that, except for the claims that require the preparation of the $(\text{CF}_3)_2\text{CHOCH}_2\text{Cl}$, the claimed process differs from the Muffler process only as to the reactant (and the corresponding product) used. Muffler standing alone would render the use of the reactant obvious since the claimed reactant is quite similar to the reactants used in the prior art. As for combining the references, as pointed out above, Muffler teaches a number of advantages in the process over the other known fluorination processes. One would be motivated to use the Muffler Process in order to realize the advantages suggested in the reference.

Electronic and steric factors of the fluorinated methyl groups would not have been expected to affect the outcome of the reaction. First, the reaction takes place at the chloro group, which is removed from the fluorinated methyl groups of the $(\text{CF}_3)_2\text{CHOCH}_2\text{Cl}$ reactant. One would not expect the electronic and steric factors of the fluorinated methyl groups so removed to greatly influence the outcome of the

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reaction. Second, Muffler teaches the use of reactants, such as $(\text{CF}_3)\text{ClCHOCH}_2\text{Cl}$ and 2-fluoro-2-chlorocyclopropyl chloromethyl ether, which also possess electronic and steric factors, affords the products one would expect.

Assertions that it is unpredictable whether the process would have worked, based on the statement in Regan that antimony fluorides did not give the desired product, is not found persuasive of patentability. The fact that a different reagent behaved in an unexpected manner does not show that one would expect the Muffler fluorination agents not to be suitable. In fact, applicants obtain the product one would predict from the teaching of Muffler.

(11) Response to Argument

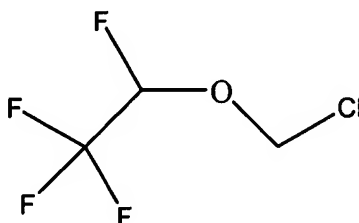
Claim Rejections –35 USC 103(a)

Starting on page 5 of their brief, appellants refer to US 4,874,901 and presents experimental examples in the brief. Both are not properly or timely presented. See 37 CFR 1.132, 1.116 and 41.33. US 4,874,901 was never presented before Final Action as evidence. The examples set forth in the brief itself were not presented before Final Action and are not in proper affidavit form. Accordingly, the evidence is not properly presented in a timely manner. As such, the evidence is not properly before the examiner nor the Board and has not been considered. Appellant's arguments based thereon are not considered to be substantiated.

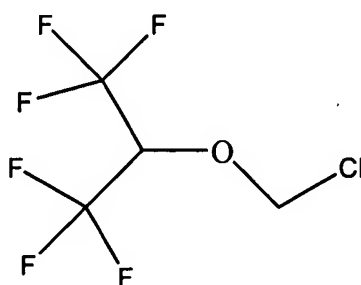
Appellant's argument that the combination of references only amounts to obvious-to-try is not seen. The Muffler reference discloses reactants that are

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structurally very similar to the instant reactant regardless of whether one looks at a two dimensional or a three dimensional image.

Reactant of Example 5 of Muffler

And a chloro analogue in Example 9.

Appellant's Reactant

It is considered that, contrary to the assertions by appellants, one would expect the instant reactant to be suitable in the Muffler process, as pointed out in the rejection

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above. One would be motivated to use this particular reactant, since it is a well known starting material in the preparation of sevoflurane $[(CF_3)_2CHOCH_2F]$, as set forth in the rejection above.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


BRIAN DAVIS
PRIMARY EXAMINER
Brian J. Davis

Primary Examiner

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Conferees:


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
Thurman K. Page


Supervisory Patent Examiner

Art Unit 1621

Samuel Barts

Primary Examiner

Art Unit 1621


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1200
